

## **REMARKS – General**

By the above amendment, Applicant has amended the specification and rewritten all claims to define the invention more particularly and distinctly so as to overcome the technical rejections and define the invention patentably over the prior art. The drawings have been amended as indicated to correct missing references and make minor corrections.

Therefore it is submitted that patentable subject matter is clearly present. If the examiner agrees but does not feel that the present claims are technically adequate, applicant respectfully requests that the examiner rewrite acceptable claims pursuant to MPEP 707.07(j)

### **The Objection To The Specification And The Claims Rejection Under 35 U.S.C. 112**

Claim 9 has been canceled

Claim 10 has been rewritten as new claim 26 and the specification has been amended to better explain the function of the top access opening.

Claim 14 has been canceled

Claims 19-20 have been canceled

### **The Rejection of claims 1,3-5,7,11,13, 15-17 under 35 U.S.C. 102(b) on Godshaw Overcome**

Claim 1 has been rewritten to more clearly define patentability over Godshaw. Applicant requests reconsideration of this rejection, as now applicable to claim 21, and corresponding dependant claims, for the following reasons:

- (1) Godshaw teaches a sleeve with pouches that fits over the top of a suitcase that hangs over one or more sides of the suitcase, not wrapped around the suitcase.
- (2) If such a pouch is to carry large articles of clothing they would need to be folded twice as shown in FIG.5, resulting in two creases to the clothing.
- (3) The current invention teaches a different method of carrying clothing on the outside of a suitcase, where the clothing wraps around the suitcase but is never folded. The novel and unobvious result is that because the clothing is not folded it is not subject to creasing along the folds.

Claims 3-5 have been rewritten as new claims 23-25 to more clearly define patentability.

Claims 7,11,13, and 15-17 have been canceled.

**The Rejection of claim 2 on Godshaw and Plath Overcome**

Claim 2 has been rewritten as New claim 22 to more clearly define patentability and to provide structure for the attachment means mentioned in new claim 21.

Since the result of new claim 21 is novel and unobvious there is no justification for combining Plath with Godshaw or any other prior art separate from applicants' disclosure.

**The Rejection of claim 8 on Godshaw and Lin Overcome**

Claim 8 has been canceled

**The Rejection of claim 9 on Godshaw and Wei-Chih Overcome**

Claim 9 has been canceled.

**The Rejection of claim 10 on Godshaw and Bieber Overcome**

Claim 10 has been rewritten as new claim 26 to more clearly define patentability.

Applicant requests reconsideration of this rejection, as now applicable to claim 26, for the following reasons:

- (1) The purpose of the top access opening, as disclosed, is to enable the user to reach the interior portion of the suitcase without having to remove the garment bag from around the suitcase. Godshaw teaches a webbing that fits over the top of a conventional suitcase that has no access opening at the top. If the Godshaw webbed pouch were used in combination with the disclosed invention, it would cover the top access opening thereby blocking access to the interior of the suitcase and defeating the purpose for having the access opening.
- (2) Bieber teaches an access opening to enclose the handle of a conventional suitcase, not to gain access to the interior of the suitcase. The access opening as disclosed is independent of the handle and is not meant to secure the handle, as described in the O.A.

**The Rejection of claim 20 on Godshaw and Plath Overcome**

Claim 20 has been canceled

**The Rejection of claim 20 on Godshaw and Schwartzstein Overcome**

Claim 20 has been canceled

**The Rejection of claim 11 and 14-20 on Latshaw Overcome**

Claims 11, and 14-20 have been canceled

**The Rejection of claim 12 on Godshaw and Latshaw and Hjelle Overcome**

Claim 12 has been canceled

**The Rejection of claim 1, 3-7, 11, 13, and 14-20 on Scicluna and Ghiassi Overcome**

Claim 1 has been rewritten to define patentability over Scicluna in view of Ghiassi. Applicant requests reconsideration of this rejection, as now applicable to claim 21, and corresponding dependant claims, for the following reasons:

- (1) Examiner states that Scicluna meets all claimed limitations except for the garment bag being wrapped around the case. Since the novel and unobvious feature of claim 21 is the garment bag wrapping around the suitcase, applicant argues that Scicluna does not apply.
- (2) Ghiassi teaches a garment bag that folds in half and drapes over a non-wheeled bag. Because the garment bag folds in half the clothes inside will be creased, a problem solved by the current invention. Ghiassi makes no mention of wrapping an un-folded garment bag completely around luggage, nor does it mention wrapping a garment bag around wheeled luggage.
- (3) Neither Scicluna or Ghiassi teaches wrapping a garment bag around wheeled luggage to avoid folding clothes in the garment bag. In view of the novel physical features in claim 21 it is clear that the combination of Scicluna and Ghiassi were not legally justified.
- (4) The attached information disclosure showing commercial success of the invention argues further in view of novelty of the present invention over prior art.

**The Rejection of claim 2 on Scicluna and Plath Overcome**

Claim 2 has been rewritten as New claim 22 to more clearly define patentability and to provide structure for the attachment means mentioned in new claim 21.

Since the result of new claim 21 is novel and unobvious there is no justification for combining Scicluna with Plath or any other prior art separate from applicants' disclosure.

**The Rejection of claim 8 on Scicluna and Lin Overcome**

Claim 8 has been canceled.

**The Rejection of claim 9 on Scicluna and Wei-Chih Overcome**

Claim 9 has been canceled.

**The Rejection of claim 12 on Scicluna and Hjelle Overcome**

Claim 12 has been canceled.

**Declaration of Commercial Success**

The disclosed invention is currently being marketed under the commercial name of “SkyRoll on Wheels” and can be seen on the web site [www.skyroll.com](http://www.skyroll.com) . To further define the invention as novel and unobvious within the commercial luggage market and the luggage industry, an information disclosure statement is attached showing industry awards, press coverage, and commercial sales information verifying that the invention is new and unique. As the product gets distributed in more retail locations, those retailers will be listed on the web site mentioned above.

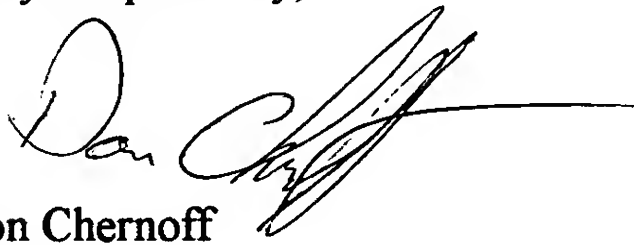
### **Conclusion**

For all the above reasons, applicant submits that the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Therefore applicant submits that this application is now in condition for allowance, which action applicant respectfully solicits. Applicant wishes to thank the Examiner for his assistance in putting this application in proper form.

### **Conditional Request for Constructive Assistance**

Applicant has amended the specification and claims of this application so that they are proper, definite, and define novel structure which is also unobvious. If, for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. 2173.02 and 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very Respectfully,

  
Don Chernoff

Enc: New sheets 5/5 of drawings.

2226 Chestertown Drive

Vienna, VA 22182

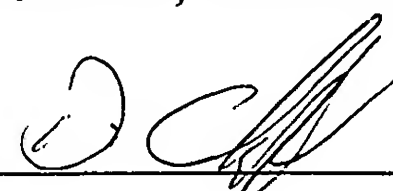
Tel. (703) 849-1492

e-mail: don@skyroll.com

### **Certificate of Mailing**

I hereby certify that this correspondence, and attachments, will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 1/27/05

Inventor's Signature: 

## **Drawings**

The attached 5 sheets include changes and corrections to Fig. 1 through 6 which replace the original drawings. The new drawings contain previously omitted references in the specifications and claims and more accurately describe the invention.

In Fig. 1 previously omitted reference numbers 15,16, 31 have been added. Reference number 17 has been replaced with reference number 41.

In Fig. 2 reference number 30 has been changed to number 33 for the set of clips at the bottom end of the garment bag to differentiate them from the clips at the top end.

In Fig. 3 reference number 30 has been changed to number 33 for the set of clips at the bottom end of the garment bag to differentiate them from the clips at the top end. Previously omitted reference numbers 27, 28, and 29 have been added.

In Fig. 4 reference number 30 has been changed to number 33 for the set of clips at the bottom end of the garment bag to differentiate them from the clips at the top end. Clips 34 have been added to comply with the specification and claims. Garment bag 20 and suitcase 10 have been separated to better show how they attach to each other. Previously omitted clips and reference numbers 30 and 31 have been added. Reference number 22 has been changed to number 41 and shown for each of 4 edges of the suitcase. Hook and loop fastener strips 40 have been added to exposed lateral side of the suitcase.

In Fig. 5 reference numbers 12, 15, 16 and 24 have been added.

In Fig. 6 reference number 17 has been changed to number 18 and a second reference number 18 has been added. Reference numbers 16, 41, and 42 have been added. Main access opening 11 has been redrawn to show it in the open position.